

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rajeev A. JAIN et al.
Title: CONTROLLED RELEASE
NANOPARTICULATE COMPOSITIONS
Appl. No.: 09/337,675
Filing Date: 06/22/1999
Examiner: Susan T. Tran
Art Unit: 1615
Confirmation Number: 9275

RENEWED PETITIONS UNDER 37 C.F.R. § 1.48(a) AND 1.183

Attention: Paul Shanowski
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Decision on Request (copy attached), mailed March 30, 2009, in connection with the above-captioned application, reconsideration is hereby requested of Applicants' original request.

In the Decision the Examiner stated that Applicants' petition under 37 C.F.R. 1.48(a) has been denied because an oath or declaration executed by all inventors has not been provided. Further, the Examiner denied Applicants' petition under 37 C.F.R. 1.181 to request waiver of the requirement to provide an executed declaration by one of the original inventors, who, despite extensive efforts by the Applicants' attorney, is unable to be located*. Finally the Examiner suggested that Applicants file a Petition under 37 C.F.R. 1.47(a) instead of 37 C.F.R. 1.181, to allow the Office to consider acceptance of a partially signed Declaration.

*The inventor that still has not been located is Kenneth Iain Cumming; inventor Maurice Clancy has been located and an executed declaration from Mr. Clancy was submitted in a supplemental request on July 17, 2008.

Applicants respectfully note that the Examiner's direction to file a petition under rule 1.47(a) is in conflict with MPEP 201.03, a copy of which is attached hereto. The Examiner's attention is directed in particular to the underlined section of page 11 of the attached copy of MPEP 201.03.

This particular section of the MPEP outlines a hypothetical situation which is entirely on point to the situation in the present application. To summarize, the MPEP describes a situation in which a correction of inventorship to add a new inventor is needed, and where an original inventor refuses to sign (or alternatively, can not be located). In such a case, the MPEP specifically states:

"Petitions under 37 CFR 1.47(a) are only applicable to an original oath or declaration and are not applicable to the reexecution of another oath or declaration by A. In such circumstances, a petition under 37 CFR 1.183 should be considered requesting waiver of the requirement that each of the actual inventors, i.e., inventor A, execute the oath or declaration, particularly where assignee consent is given to the requested correction."

This section also explains that a petition under 37 CFR 1.47(a) should be used if the newly determined inventor to be added refuses to sign. In the present application, the inventor to be added (Gary Liversidge) has executed the declaration.

The MPEP goes on to state that absent assignee's consent, the petition under 1.183 will be evaluated as to whether the nonsigning original inventor was given the opportunity to reexecute the oath or declaration, or whether the nonsigning original inventor could not be reached.

Applicants note that in the present application, the Assignee's consent to the correction of the inventorship is already of record, and that extensive and diligent efforts have been made to locate inventor Cumming to give him the opportunity to reexecute the declaration. Further, Applicants note that filing a petition under 37 C.F.R. 1.47(a) to request the application to proceed without the signature of inventor Cumming would be inappropriate, and in conflict with MPEP 201.03.

Applicants also respectfully disagree with the Examiner's assertion that evidence has not been presented which establishes that the present situation is extraordinary and justice requires waiver of the Office requirement that the declaration be executed by each inventor. Applicants assert that the situation is extraordinary as the declaration was signed by the

originally named inventors in 1999, 10 years ago. During the course of the last 10 years several of the original inventors are no longer employed by the Assignee, and have changed correspondence addresses several times. Further, if the application is to proceed with the correctly named inventors, Applicants assert the proper course of action is approval of a waiver as requested in the petition under 1.183, and approval of the petition under 1.48(a) to add Gary Liversidge as an inventor.

In view of the foregoing, Applicants earnestly and respectfully request that the petitions under 37 C.F.R. 1.48(a) and 1.183 be approved and that the application be allowed to proceed with the corrected inventorship.

In accordance with the Decision on Request, Applicants believe no fees are due with this Renewed Petition, however, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date April 15, 2009

By Michele M. Simkin

FOLEY & LARDNER LLP
Customer Number: 31049
Telephone: (202) 672-5538
Facsimile: (202) 672-5399

Michele M. Simkin
Attorney for Applicant
Registration No. 34,717

1. 201.03 Correction of Inventorship in an Application

[R-5] - 200 Types, Cross-Noting, and Status of Application

201.03 Correction of Inventorship in an Application [R-5]

Correction of inventorship in an application is permitted by amendment under 35 U.S.C. 116, which is implemented by 37 CFR 1.48. The utilization of a request under 37 CFR 1.48 will generally correct the inventorship in the application in which it is filed. 37 CFR 1.48(a) is directed at correcting the inventorship in an application where the inventorship was improperly set forth in the executed oath or declaration filed in the application. 37 CFR 1.48(b) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to prosecution of the application, e.g., claim cancellation or amendment, fewer than all of the currently named inventors are the actual inventors of the remaining claims. 37 CFR 1.48(c) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to amendment of the claims to include previously unclaimed but disclosed subject matter, one or more inventors of the amended subject matter must be added to the current inventorship. 37 CFR 1.48(d) is directed at provisional applications where an inventor is to be added. 37 CFR 1.48(e) is directed at provisional applications where an inventor is to be deleted. 37 CFR 1.48(f) operates to automatically correct the inventorship upon filing of a first executed oath or declaration under 37 CFR 1.63 by any of the inventors in a nonprovisional application or upon filing of a cover sheet in a provisional application.

Correction of inventorship may also be obtained by the filing of a continuing application under 37 CFR 1.53 without the need for filing a request under 37 CFR 1.48, either in the application containing the inventorship err(using a copy of the executed oath or declaration from the parent application)or (to be abandoned) or in the continuing application. The continuing application must be filed with the correct inventorship named therein. The filing of a continuing application to correct the inventorship is appropriate if at least one of the correct inventors has been named in the prior application (35 U.S.C. 120 and 37 CFR 1.78(a)(1)). That is, at least one of

the correct inventors must be named in the executed oath or declaration filed in the prior application, or where no executed oath or declaration has been submitted in the prior application, the name of at least one correct inventor must be set forth in the application papers pursuant to 37 CFR 1.41(a)(1). Where the name of at least one inventor is to be added, correction of inventorship can be accomplished by filing a continuing application under 37 CFR 1.53(b) with a newly executed oath or declaration under 37 CFR 1.63(a). Where the name of an inventor(s) is to be deleted, applicant can file a *>continuation or divisional< application >(using a copy of the executed oath or declaration from the parent application)< with a request for deletion of the name of the inventor(s). >See 37 CFR 1.63(d)(2). If a continuing application is filed with a new executed oath or declaration properly naming the correct inventors, a request for deletion of the name(s) of the person(s) who are not inventors in the continuing application is not necessary.< The continuing application may be filed under 37 CFR 1.53(b) or, if the application is for a design patent, under 37 CFR 1.53(d). Note the requirements of 37 CFR 1.78 (a)(1)(ii).

In certain instances where the statement of the lack of deceptive intent of the inventor to be added or deleted cannot be obtained, a petition under 37 CFR 1.183 requesting waiver of that requirement may be possible.

For provisional applications, it may not be necessary to correct the inventorship under 37 CFR 1.48 (d) and (e) unless there would be no overlap of inventors upon the filing of the nonprovisional application with the correct inventorship. See subsections V. and VI. below.

The need to correct the inventorship in any U.S. nonprovisional or provisional application may in part be dependent upon whether a foreign filing under the Paris Convention will occur subsequent to the U.S. filing. See MPEP § 201.13.

37 CFR 1.48 does not apply to reissue applications as is noted in its title, whether correcting an inventorship error in the patent to be reissued or in the reissue application itself. Where an error in inventorship in a patent is to be corrected via a reissue application, see MPEP § 1412.04. Where such an error is to be corrected via a certificate of correction under 37 CFR 1.324, see MPEP § 1481.

Where a request under 37 CFR 1.48 is denied in a final agency action, the examiner must determine whether a rejection under 35 U.S.C. 102(f) or (g) is appropriate. Where the request under 37 CFR 1.48 has been entered (for a decision thereon) and is dismissed (due to a defect that can be corrected) consideration under 35 U.S.C. 102(f) or (g) would be premature.

Although 37 CFR 1.48 does not contain a diligence requirement for filing the request, once an inventorship error is discovered, timeliness requirements under 37 CFR 1.116 and 37 CFR 1.312 apply. For allowed applications where the issue fee has been paid prior to the entry of a request under 37 CFR 1.48, if the request under 37 CFR 1.48 is dismissed or denied in an Office action, the application must be withdrawn from issue so that applicant would be given time to correct the defect(s). If the request under 37 CFR 1.48 is granted, then it would not be necessary to withdraw the application from issue.

Requests under 37 CFR 1.48 are generally decided by the primary examiner except:

(A) When the application is involved in an interference (decided by the Board of Patent Appeals and Interferences);

(B) When the application is a national stage application filed under 35 U.S.C. 371 which, as of the date of filing of the request, has not been accepted as satisfying the requirements for entry into the national stage (decided in the PCT Legal Office); and

(C) When accompanied by a petition under 37 CFR 1.183 requesting waiver of a requirement under 37 CFR 1.48(a) or (c), e.g., waiver of the statement of lack of deceptive intent by an inventor to be added or deleted, or waiver of the reexecution of the declaration by all of the inventors (decided in the Office of Petitions).

When any request for correction of inventorship under 37 CFR 1.48(a)-(c) is granted, the examiner will acknowledge any addition or deletion of the names of inventors by using either form paragraph 2.14 or form paragraph 2.14.01 in the next Office communication to applicant or his/her attorney. It will be necessary to revise the PALM records, issue a corrected filing receipt, and change the bib-data sheet. The correction should be noted on the original oath or declaration by writing in ink in the

left column "See Paper No. ___ for inventorship corrections." See MPEP § 605.04(g). For Image File Wrapper (IFW) processing, see the IFW Manual.

2. ¶ 2.14 Correction of Inventorship Under 37 CFR 1.48(a) or (c), Sufficient

In view of the papers filed [1], it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48 ([2]). The inventorship of this application has been changed by [3].

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

3. Examiner Note

1. In bracket 2, insert --a-- or --c--, as appropriate.
2. In bracket 3, insert explanation of correction made, including addition or deletion of appropriate names.

4. ¶ 2.14.01 Correction of Inventorship Under 37 CFR 1.48(b), Sufficient

In view of the papers filed [1], the inventorship of this nonprovisional application has been changed by the deletion of [2].

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

5. Examiner Note

1. This form paragraph is to be used only for 37 CFR 1.48(b) corrections.
2. In bracket 2, insert the names of the deleted inventor(s).

The grant or denial of a request under 37 CFR 1.48(a) may result in the lack of inventorship overlap between a parent application and a continuing application and

the consequent inability to claim benefit in the continuing application of the parent application's filing date under 35 U.S.C. 120. Intervening references must then be considered.

For correction of inventorship in a patent, see 37 CFR 1.324 and MPEP § 1481.

A request under 37 CFR 1.48 will not be required:

(A) Where an application is to issue with the correct inventorship based on the allowed claims even though the application may have been filed with an incorrect inventorship based on the claims as originally submitted;

(B) Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required. See MPEP § 605.04(g). Reference to the notification will be made on the previously filed oath or declaration;

(C) Where an inventor's name has been changed after the application has been filed, see MPEP § 605.04(c);

(D) Where a court has issued an order under 35 U.S.C. 256 for correction of the inventorship of a patent, it should be submitted directly to the Certificate of Correction Division along with **> form PTO/SB/44 (see MPEP § 1485).< A new oath or declaration under 37 CFR 1.63 is not required;

(E) Where there is no change of individual but an incorrect name was given, a petition under 37 CFR 1.182 should be filed requesting correction of applicant's name;

(F) In a nonprovisional application filed under 35 U.S.C. 111(a), where the first-filed executed oath or declaration was filed on or after December 1, 1997 and names the correct inventors, but the inventive entity on the executed oath or declaration differs from that which was set forth on filing of the application, e.g., the application transmittal letter or an unexecuted oath or declaration. See 37 CFR 1.48(f)(1);

(G) In a provisional application filed under 35 U.S.C. 111(b), where the cover sheet was filed on or after December 1, 1997 which names the correct inventors, but the inventive entity on the cover sheet differs from that which was set forth on filing of the provisional application without a cover sheet. See 37 CFR 1.48(f)(2).

6. I. APPLICATIONS FILED UNDER 37 CFR 1.53(f) - NO
OATH/DECLARATION

The Office will issue a filing receipt listing the inventors identified at the time of filing of the application even if the application was filed under 37 CFR 1.53(f) without an executed oath or declaration. Where the first-filed executed oath or declaration was filed on or after December 1, 1997 and sets forth an inventive entity which is different from the inventive entity initially set forth at the time of filing of the application, the actual inventorship of the application will be taken from the executed oath or declaration. See 37 CFR 1.41(a)(1). A request under 37 CFR 1.48(a), (b), or (c) will not be necessary. See 37 CFR 1.48(f).

Where the first-filed executed oath or declaration was submitted prior to December 1, 1997 in an application filed without an executed oath or declaration, if the inventive entity identified on the executed oath or declaration differs from the inventive entity identified at the time of filing of the application, a request under 37 CFR 1.48(a) or (c) must also be submitted.

The original named inventors should not execute or submit an oath or declaration under 37 CFR 1.63 merely to timely complete the filing requirements in reply to a "Notice to File Missing Parts of Application" where the possibility of an error in inventorship has been discovered, nor should the oath or declaration be signed by someone who cannot properly make the averments therein. Additional time to reply to the Notice is available under 37 CFR 1.136(a) and possibly under 37 CFR 1.136(b). See MPEP § 710.02(d).

7. Example

A nonprovisional application is filed (either prior to, on or after December 1, 1997) naming A as the sole inventor without an executed oath or declaration under 37 CFR 1.63. Only claim 1 is presented.

A "Notice to File Missing Parts of Application" is mailed to the applicant requiring an oath or declaration under 37 CFR 1.63. In timely reply thereto after December 1, 1997, a preliminary amendment adding claim 2, and a declaration under 37 CFR 1.63 executed by inventors A and B are submitted with B being added in view of claim 2. A request under 37 CFR 1.48(c) is not required, in that 37 CFR 1.48(f)(1) will act to set forth an inventorship of A and B.

Similarly, where a preliminary amendment canceling or amending claims concomitantly requires the deletion of an inventor, such deletion may be accomplished by the submission of a first-filed executed oath or declaration on or after December 1, 1997 naming the actual inventive entity. A request under 37 CFR 1.48(b) would not be necessary.

8. II. 37 CFR 1.48(a)

9. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Under 37 CFR 1.48(a), if the correct inventor or inventors are not named in an executed oath or declaration under 37 CFR 1.63 in a nonprovisional application for patent, the application can be amended to name only the actual inventor or inventors so long as the error in the naming of the inventor or inventors occurred without any deceptive intention on the part of the person named as an inventor in error or the person who through error was not named as an inventor.

37 CFR 1.48(a) requires that the amendment be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Correction may be requested in cases where the person originally named as inventor was in fact not an inventor or the sole inventor of the subject matter being claimed. If such error occurred without any deceptive intention on the part of the inventor named and/or not named in error, the Office has the authority to substitute the true inventive entity for the erroneously named inventive entity. Instances where corrections can be made include changes from: a mistaken sole inventor to a different but actual sole inventor; a mistakenly identified sole inventor to different, but actual, joint inventors; a sole inventor to joint inventors to include the original sole inventor; erroneously identified joint inventors to different but actual joint inventors; erroneously identified joint inventors to a different, but actual, sole inventor. (Note that 35 U.S.C. 120 and 37 CFR 1.78 require an overlap of inventorship, hence, refiling, rather than requesting under 37 CFR 1.48, to change inventorship where the

change would not result in an inventorship overlap may result in the loss of a benefit claim.)

10. A. Statement of Lack of Deceptive Intention

Where a similar inventorship error has occurred in more than one application for which correction is requested wherein petitioner seeks to rely on identical statements, only one original set need be supplied if copies are submitted in all other applications with a reference to the application containing the originals (original oaths or declarations under 37 CFR 1.63 and written consent of assignees along with separate processing fees must be filed in each application).

The statement required from each inventor being added or deleted may simply state that the inventorship error occurred without deceptive intention. The statement need not be a verified statement (see MPEP § 410).

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a *>petition< and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. *In re Cooper*, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction.

Where there is more than one assignee giving its consent, the extent of that interest

(percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor.

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

11. B. Oath or Declaration

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

Conflicting oaths or declarations filed: If the first executed oaths or declarations that are submitted name different inventive entities (e.g., one declaration names A, B, and C as inventors and a second declaration names D as the inventor) and are filed

on the same day, the application will be considered to name the inventors named in both declarations (A, B, C, and D) and a new oath or declaration in compliance with 37 CFR 1.63 including the entire inventive entity will be required. Where an application is filed with an executed declaration under 37 CFR 1.63 naming an inventive entity that is in conflict with another paper filed in the application, such as the transmittal letter, the executed declaration will govern. However, where an executed declaration is never submitted and the application papers are in conflict as to the inventorship, each party identified as an inventor on filing will be considered to have been named as part of the inventive entity. See 37 CFR 1.41(a)(1).

37 CFR 1.47 is available to meet the requirement for an oath or declaration under 37 CFR 1.63 as for example where A, B, and C were originally named as inventors and D who refuses to cooperate is to be later added as an inventor. The oath or declaration under 37 CFR 1.63 of inventor D may be supplied pursuant to 37 CFR 1.47(a), but note that the required 37 CFR 1.48(a)(2) statement must still be supplied by inventor D (an unlikely event in view of the inability to obtain the executed oath or declaration under 37 CFR 1.63), or waiver thereof petitioned under 37 CFR 1.183. Alternatively, where D is to be added as an inventor (where inventors A, B, and C have previously executed the application under 37 CFR 1.63) and it is original inventor A who refuses to cooperate, the statement under 37 CFR 1.48(a)(2) is only required to be signed by inventor D. Originally named inventor A is merely required to reexecute an oath or declaration in compliance with 37 CFR 1.63. Petitions under 37 CFR 1.47 are only applicable to an original oath or declaration and are not applicable to the reexecution of another oath or declaration by A. In such circumstances, a petition under 37 CFR 1.183 should be considered requesting waiver of the requirement of 37 CFR 1.64 that each of the actual inventors, i.e., inventor A, execute the oath or declaration, particularly where assignee consent is given to the requested correction. Absent assignee consent, the petition under 37 CFR 1.183 requesting waiver of the reexecution of the oath or declaration will be evaluated as to whether the nonsigning inventor was actually given the opportunity to reexecute the oath or declaration, or whether the nonsigning inventor could not be reached.

Applications filed with a petition under 37 CFR 1.47 and a request under 1.48(a) will be forwarded to the Office of Petitions, after mailing the filing receipt by the Office of Initial Patent Examination, for consideration of the petition and the request. In those instances wherein a request under 37 CFR 1.48(a) and a petition under 37 CFR 1.47 have both been filed in an application, the Office of Petitions may first issue a decision on the request under 37 CFR 1.48(a) so as to determine the appropriate oath or declaration under 37 CFR 1.63 required for the petition under 37 CFR 1.47.

The oath or declaration submitted subsequent to the filing date (37 CFR 1.53(f)) of an application filed under 37 CFR 1.53(b) must clearly identify the previously filed specification it is intended to execute. See MPEP § 601.01(a) and § 602.

12. C. Fee

Where waiver under 37 CFR 1.183 is requested in relation to a requirement under 37 CFR 1.48(a), a processing fee under 37 CFR 1.48(a) and a petition fee under 37 CFR 1.183 are required. Similarly, where in addition to a request under 37 CFR 1.48, two petitions under 37 CFR 1.183 are presented, e.g., one requesting waiver of a requirement under 37 CFR 1.48 and the other requesting waiver of the reexecution of an oath or declaration under 37 CFR 1.64, three fees are required (one for the request filed under 37 CFR 1.48 and two for the petitions filed under 37 CFR 1.183).

Where a similar error has occurred in more than one application a separate processing fee must be submitted in each application in which correction is requested.

If the processing fee has not been submitted or authorized the request will be dismissed.

13. D. Written Consent of Assignee

The written consent of every existing assignee of the original named inventors must be submitted. 37 CFR 1.48(a)(5). 37 CFR 1.48(a) does not limit assignees to those who are recorded in the U.S. Patent and Trademark Office records. The Office employee deciding the request should check the file record for any indication of the existence of an assignee (e.g., a small entity assertion from an assignee).

Where no assignee exists requester should affirmatively state that fact. If the file record including the request is silent as to the existence of an assignee it will be presumed that no assignee exists. Such presumption should be set forth in the decision to alert requesters to the requirement.

The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity assertion, it is also acceptable. Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP § 324.

14. E. Continuing Applications

35 U.S.C. 120 permits a continuing application to claim the benefit of the filing date of a copending, previously filed, parent application provided there is inventorship overlap between the continuing application and the parent application. If the inventive entity of a continuing application includes an inventor named in the parent application, the inventorship overlap required by 35 U.S.C. 120 is met.

15. Example

The parent application names inventors A and B and claims inventions 1 and 2. Inventor A contributes only to invention 1 and inventor B contributes only to invention 2. A restriction requirement is made and invention 1 was elected. Upon allowance of claims directed to invention 1 and cancellation of claims directed to invention 2, a request under 37 CFR 1.48(b) was filed requesting deletion of inventor B. The request under 37 CFR 1.48(b) was granted by the primary examiner. Prior to the issuance of the parent application, a divisional application claiming benefit under 35 U.S.C. 120 to the parent application, is filed claiming only invention 2 and naming

only inventor B. The inventorship overlap required by 35 U.S.C. 120 is met in this instance even though at the time of filing of the divisional application, the inventorship overlap was lost as a result of the deletion of an inventor in the parent application. The overlap of inventorship need not be present on the date the continuing application is filed nor present when the parent application issues or becomes abandoned.

On filing a continuing application under 37 CFR 1.53(b) it should not be assumed that an error in inventorship made in a parent application was in fact corrected therein in response to a request under 37 CFR 1.48(a) unless a decision from the U.S. Patent and Trademark Office to that effect was received by the requester. A continuing application naming the additional inventor can be filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) with a newly executed oath or declaration by the new inventive entity along with a request for benefit under 35 U.S.C. 120 without the need for a decision on the request under 37 CFR 1.48 filed in the parent application.

Should an error in inventorship in a parent application be discovered, whether it is the need to add and/or to delete inventors, when preparing to file a continuing application, the continuing application may be filed under 37 CFR 1.53(b) with the correct inventive entity without the need for a request under 37 CFR 1.48(a) in the parent or continuing application provided the parent application is to be abandoned on filing of the continuing application. In filing ~~a~~ continuation or divisional application under 37 CFR 1.53(b), a copy of an oath or declaration from the prior application can only be used where inventors are to be deleted (37 CFR 1.53(b)(1) and 37 CFR 1.63(d)(1)(ii)), but not where inventors are to be added. Where inventors are to be added, a newly executed oath or declaration must be submitted. See 37 CFR 1.63(d)(5).

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a request under 37 CFR 1.48(a) or (c) to add an inventor to a parent application that was not acted on (e.g., filed after final rejection) will be automatically considered in the CPA. Until the request is granted, the inventorship remains the same as the prior application. Note, however, that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications. If the application is a design

application, after discovery of an inventorship error, the application can also be refiled under 37 CFR 1.53(d)(4) as a CPA where inventors are only to be deleted.

In filing a continuing application to correct the inventorship, it is important to recognize that 37 CFR 1.78 requires for purposes of claiming the benefit of the prior application that the prior application must either have had the filing fee, or the retention fee as set forth in 37 CFR 1.21(l), paid within the period set forth in 37 CFR 1.53(f) so as to establish copendency. See 37 CFR 1.78(a)(1). Effective July 1, 2005, the processing and retention fee (37 CFR 1.21(l)) practice has been eliminated. The basic filing fee (rather than just the processing and retention fee set forth in former 37 CFR 1.21(l)) must be paid within the pendency of a nonprovisional application in order to permit benefit of the application to be claimed under 35 U.S.C. 120, 121, or 365(c) in a subsequent nonprovisional or international application. See 37 CFR 1.78(a)(1)(ii).

Should a *>continuation or divisional< application be filed under 37 CFR 1.53(b)(1) where a copy of the oath or declaration from the prior application is utilized (or under 37 CFR 1.53(d) as a CPA if the prior application is a design application) purporting to add an inventor, the inventorship of the prior application will be retained in the continuing application as addition of an inventor is not permitted in these instances. The absence of a request to correct the inventorship submitted with the continuing application will not affect the filing date of the continuing application. However, the retained inventorship must then be corrected by the filing of a request under 37 CFR 1.48(a) in the *>continuation or divisional< application stating that the error in failing to name the additional inventor in the prior application was without deceptive intention. Where an inventor is to be added, it is recommended that a *>continuation or divisional< application be filed under 37 CFR 1.53(b) with a newly executed oath or declaration and not be filed with a copy of the oath or declaration from the prior application. This procedure eliminates the need for a request under 37 CFR 1.48.

An inventorship error discovered while prosecuting a continuing application that occurred in both an abandoned parent application and the continuing application can be corrected in both applications by filing a single request in the continuing application (e.g., A + B named in parent, B + C named in continuing application, actual inventorship is C + D thereby eliminating inventorship overlap and resulting

loss of benefit claim under 35 U.S.C. 120 if the error is not corrected in abandoned parent application as well as in continuation application). Absent such loss of inventorship overlap, correction need not be made in the abandoned application.

When entering the national stage under 35 U.S.C. 371, correction of inventorship is via the provisions of 37 CFR 1.497(d). See MPEP § 1893.01(e).

16. ¶ 2.13 Correction of Inventorship Under 37 CFR 1.48(a), Insufficient

The request to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

17. Examiner Note

1. This form paragraph should only be used in response to requests to correct an error in the naming of the prior inventors in nonprovisional applications. If the request is merely to delete an inventor because claims were canceled or amended such that the deleted inventor is no longer an actual inventor of any claim in the application, use form paragraph 2.13.01 instead of this form paragraph.

Potential rejections

A rejection under 35 U.S.C. 102(f) or (g) must be considered if the request is denied.

The grant or denial of the request may result in the loss of inventorship overlap between a parent application and a continuing application and an inability to claim benefit in the continuing application of the parent application's filing date under 35 U.S.C. 120. Intervening references must then be considered.

2. A primary examiner may not decide the request if the request is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.48(a) (typically a refusal of one of the inventors to be added or deleted to execute the required statement of facts) - the request for correction of inventorship and request for waiver of the rules should be forwarded to the Office of Petitions.

3. One or more of form paragraphs 2.13a - 2.13e should follow this form paragraph, as applicable.

4. Where it appears that: 1) the inventor(s) to be added or deleted may be hostile and will not execute a required statement of facts; and 2) the actual inventorship would overlap the original inventorship (37 CFR 1.78), follow this form paragraph with form paragraph 2.13f.

5. Requests under 37 CFR 1.41 to change inventorship where an executed oath or declaration has not been filed are to be acted upon by OIPE.

6. Where there is a correction in a person's name, e.g., due to misspelling, or marriage, a request under 37 CFR 1.48 is inappropriate. See MPEP § 605.04(b) and (c) for name changes.

7. An initial executed oath or declaration under 37 CFR 1.63 may change the inventorship as originally set forth when the application is filed without an executed oath or declaration without request for correction of inventorship (37 CFR 1.48(f)).

18. ¶ 2.13a Statement of Facts Problem (for Use Following FP 2.13, If Applicable)

The statement of facts by an inventor or inventors to be added or deleted does not explicitly state that the inventorship error occurred without deceptive intent on his or her part or cannot be construed to so state.

19. ¶ 2.13b No New Oath or Declaration (for Use Following FP 2.13 or 2.13.02, If Applicable)

An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

20. ¶ 2.13c Required Fee Not Submitted (for Use Following FP 2.13, 2.13.01 or 2.13.02, If Applicable)

It lacks the required fee under 37 CFR 1.17(i).

21. ¶ 2.13d Written Consent Missing (for Use Following FP 2.13 or 2.13.02, If Applicable)

It lacks the written consent of any assignee of one of the originally named inventors.

22. ¶ 2.13e 37 CFR 3.73(b) Submission (for Use Following FP 2.13 or 2.13.02, If Applicable)

A 37 CFR 3.73(b) submission has not been received to support action by the assignee.

23. ¶ 2.13f Hostile Inventor(s)/Inventorship Overlap (for Use Following FP 2.13, If Applicable)

As it appears that a party required by 37 CFR 1.48(a)(2) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under 37 CFR 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an assignee who has given its consent to the requested inventorship correction, MPEP § 201.03, Statement of Lack of Deceptive Intention, or b) refiling the application (where addition is needed under 37 CFR 1.53(b) with a new oath or declaration and any necessary petition under 37 CFR 1.47, or where only deletion is needed, either under 37 CFR 1.53(b) utilizing a copy of a prior oath or declaration under 37 CFR 1.63(d)(1)(iv), or under 37 CFR 1.53(d)) (design applications only), thereby eliminating the need for a 37 CFR 1.48 request.

24. ¶ 2.13.01 Correction of Inventorship Under 37 CFR 1.48(b), Insufficient

The request for the deletion of an inventor in this nonprovisional application under 37 CFR 1.48(b) is deficient because:

25. Examiner Note

1. This form paragraph should only be used when the inventorship was previously correct when originally executed but an inventor is being deleted because claims have been amended or canceled such that he or she is no longer an inventor of any remaining claim in the non-provisional application. If the inventorship is being corrected because of an error in naming the correct inventors, use form paragraph 2.13 instead of this form paragraph.

2. Follow this form paragraph with one or both of form paragraphs 2.13c and 2.13g.
3. See note 1 of form paragraph 2.13, Potential rejections.

26. ¶ 2.13g Statement Under 37 CFR 1.48(b)(2) Problem (for Use Following FP 2.13.01, If Applicable)

The request was not accompanied by the statement required under 37 CFR 1.48 (b)(2).

27. ¶ 2.13.02 Correction of Inventorship Under 37 CFR 1.48(c), Insufficient

The request to correct the inventorship in this nonprovisional application under 37 CFR 1.48(c) requesting addition of an inventor(s) is deficient because:

28. Examiner Note

1. This form paragraph should only be used when the inventorship was previously correct when the application was originally executed, but the inventorship now needs to be changed due to subsequent addition of subject matter from the specification to the claims, which subject matter was contributed by a party not originally named as an inventor.

2. See note 2 of form paragraph 2.13.

3. Follow this form paragraph with any of form paragraphs 2.13b- 2.13e or 2.13h.

4. See note 1 of form paragraph 2.13, Potential rejections.

5. See notes 4-7 of form paragraph 2.13.

29. ¶ 2.13h Statement of Facts, Added Inventor (for Use Following FP 2.13.02, If Applicable)

The statement of facts by the inventor(s) to be added does not explicitly state that the amendment of the inventorship is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intent on the part of the inventor(s) to be added, or cannot be construed to so state.

30. ¶ 2.14 Correction of Inventorship Under 37 CFR 1.48(a) or (c), Sufficient

In view of the papers filed [1], it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48 ([2]). The inventorship of this application has been changed by [3].

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

31. Examiner Note

1. In bracket 2, insert --a-- or --c--, as appropriate.
2. In bracket 3, insert explanation of correction made, including addition or deletion of appropriate names.

32. ¶ 2.14.01 Correction of Inventorship Under 37 CFR 1.48(b), Sufficient

In view of the papers filed [1], the inventorship of this nonprovisional application has been changed by the deletion of [2].

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

33. Examiner Note

1. This form paragraph is to be used only for 37 CFR 1.48(b) corrections.
2. In bracket 2, insert the names of the deleted inventor(s).

34. III. 37 CFR 1.48(b)

35. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(b) *Nonprovisional application-fewer inventors due to amendment or cancellation of claims.* If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

- (1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and
- (2) The processing fee set forth in § 1.17(i).

37 CFR 1.48(b) provides for deleting the names of persons originally properly included as inventors, but whose invention is no longer being claimed in a nonprovisional application. Such a situation would arise where claims have been amended or deleted during prosecution because they are unpatentable or as a result of a requirement for restriction of the application to one invention, or for other reasons. A request under 37 CFR 1.48(b) to delete an inventor would be appropriate prior to an action by the TC where it is decided not to pursue particular aspects of an invention attributable to some of the original named inventors.

37 CFR 1.48(b) requires that the amendment be accompanied by: (1) a request including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and (2) a fee under 37 CFR 1.17(i). The statement may be signed by applicant's registered attorney or agent who then takes full responsibility for ensuring that the inventor is not being improperly deleted from the application. Written consent of any assignee is not required for requests filed under 37 CFR 1.48(b).

36. IV. 37 CFR 1.48(c)

37. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(c) *Nonprovisional application-inventors added for claims to previously unclaimed subject matter.* If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 CFR 1.48(c) provides for the situation where a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application when an executed declaration under 37 CFR 1.63 was first filed. In such a situation, the nonprovisional application may be amended pursuant to 37 CFR 1.48(c) to add claims directed to the originally unclaimed but disclosed subject matter and also to name the correct inventors for the application based on the newly

added claims. Any claims added to the application must be supported by the disclosure as filed and cannot add new matter.

37 CFR 1.48(c) requires that the amendment must be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor that the amendment is necessitated by an amendment to the claims and that the inventorship error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor; (4) the fee under 37 CFR 1.17(i); and (5) the written consent of any assignee of the original named inventors.

38. V. 37 CFR 1.48(d)

39. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(d) *Provisional application-adding omitted inventors.* If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and

(2) The processing fee set forth in § 1.17(q).

37 CFR 1.48(d) provides a procedure for adding the name of an inventor in a provisional application, where the name was originally omitted without deceptive intent.

37 CFR 1.48(d) requires that the amendment be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and (3) the fee set forth in 37 CFR 1.17(q). The statement of lack of deceptive intent may be included in the request and may be signed by a registered attorney or agent. A statement of lack of deceptive intent is not required from any of the original or to be added inventors.

See also discussion below regarding requests filed under 37 CFR 1.48(e).

40. VI. 37 CFR 1.48(e)

41. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(e) *Provisional application-deleting the name or names of the inventor or inventors.* If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;

(3) The processing fee set forth in § 1.17(q); and

(4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 CFR 1.48(e) provides a procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application.

37 CFR 1.48(e) requires that the amendment be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement of lack of deceptive intent by the person whose name is being deleted establishing that the error occurred without deceptive intention on his or her part; (3) the fee set forth in 37 CFR 1.17(q); and (4) the written consent of any assignee.

Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed nonprovisional application under 35 U.S.C. 111(a) that is filed within twelve months of an earlier provisional application may claim benefits based on the earlier filed provisional application so long as both applications have at least one inventor in common. An error in not naming or in naming a person as an inventor in a provisional application would not require correction under either 37 CFR 1.48(d) (to add an inventor) or 37 CFR 1.48(e) (to delete an inventor) in the provisional application so long as the nonprovisional application naming the correct inventorship would contain an overlap of at least one inventor with the provisional application. The existence of inventorship overlap would prevent the original inventorship error from having any effect upon the ability of the provisional application to serve as a basis for a benefit claim under 35 U.S.C. 119(e) with the U.S. Patent and Trademark Office. If, however, applicant chooses to correct the inventive entity of a provisional application, for example, to permit the provisional application to serve as the basis of a priority claim in a foreign country, 37 CFR 1.48(d) and (e) set forth the procedures for adding one or more actual inventors and for deleting one or more erroneously named inventors respectively. In the situation where an inventor was not named in a provisional application and an inventor was also erroneously named in the same provisional application and correction is desired, a request under 37 CFR 1.48(d) and a request under 37 CFR 1.48(e) would be required. Where an inventorship error in a provisional application is desired to be corrected after expiration of twelve months from the filing date of the provisional application, a request under 37 CFR 1.48(d) and/or 37 CFR 1.48(e) may still be filed with OIPE, which handles requests under 37 CFR 1.48(d) and (e), to correct the inventorship in provisional applications.

42. VII. 37 CFR 1.48(f)

43. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(f)

(1) Nonprovisional application-filing executed oath/declaration corrects inventorship.

If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) and (f) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.

(2) Provisional application filing cover sheet corrects inventorship. If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship.

37 CFR 1.48(f)(1) and (f)(2) will act to automatically correct an earlier identification of inventorship in a nonprovisional application by the filing of an initial executed oath or declaration and in a provisional application by the filing of an initial cover sheet. A request and fee is not required for the inventorship correction to occur.

The provision in 37 CFR 1.48(f)(1) for changing the inventorship only applies if an executed oath or declaration under 37 CFR 1.63 has not been submitted by any of the inventors. In this situation, the submission of an executed oath or declaration

under 37 CFR 1.63 by any of the inventors is sufficient to correct an earlier identification of inventorship. A first-filed oath or declaration under 37 CFR 1.63 executed by less than all of the inventors initially identified will, under 37 CFR 1.48(f)(1), determine the inventorship in the application. Any subsequent oath or declaration filed by a different inventive entity will not be effective under 37 CFR 1.48(f)(1) to correct the inventorship that was specified in the first-filed oath or declaration.

37 CFR 1.48(f)(1) is not applicable for national stage applications filed under 35 U.S.C. 371 where the inventorship has been erroneously named in the international application. Accordingly, if the inventorship set forth in the oath or declaration filed in the national stage application differs from the inventorship specified in the international application, the requirements of 37 CFR 1.497(d) must be satisfied. See MPEP § 1893.01(e).

44. VIII. 37 CFR 1.48(g)

45. 37 CFR 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(g) *Additional information may be required.* The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

ELAN DRUG DELIVERY, INC.
C/O FOLEY & LARDNER LLP
3000 K STREET, N.W.
SUITE 500
WASHINGTON DC 20007-5109

COPY MAILED

MAR 30 2009

OFFICE OF PETITIONS

In re Application of	:	
Rajeev A. Jain, Jon Swanson,	:	
Robert Hontz, John Devane,	:	
Jenneth Iain Cumming, Maurice	:	
Joseph Anthony Clancy, and	:	
Janet Elizabeth Codd	:	DECISION ON TWO PETITIONS
Application No. 09/337,675	:	UNDER
Filing Date: June 22, 1999	:	37 C.F.R. §§ 1.48 AND 1.183
Attorney Docket Number:	:	
029318/0497	:	
Title: CONTROLLED-RELEASE	:	
NANOPARTICULATE COMPOSITIONS	:	

Background

This is a decision on the two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on July 3, 2008. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

Receipt of the July 17, 2008 supplement to the petition pursuant to 37 C.F.R. § 1.48(a)(3) petition is acknowledged.

In short, Petitioner has requested that Gary Liversidge be added as an inventive entity, and that the Office waive the requirement that the applicant provide an oath or declaration by the actual

inventors (Petitioner has submitted declarations that have been executed by each of the inventors save Mr. Cumming). With these submissions, Petitioner has submitted, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R. § 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

The petition pursuant to 37 C.F.R. § 1.48(a)(3) is DISMISSED.

The petition pursuant to 37 C.F.R. § 1.183 is DISMISSED.

A discussion follows.

Applicable Rules

37 C.F.R. § 1.48(a) sets forth, *in toto*:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

Analysis of the Petition Pursuant to Rule § 1.183

With this petition, Petitioner has requested the waiver 37 C.F.R. § 1.64. This request is being treated as a request for the waiver of 37 C.F.R. § 1.48(a)(3).

In order to submit a grantable petition pursuant to 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has asserted, *much less established*, that either condition exists in this case. As such, the circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

Assuming arguendo that Petitioner had made these two assertions, there does not appear to be anything extraordinary about an Applicant who is faced with the requirement that each of the inventors must execute a declaration, and that justice requires the waiver of the Office requirement that the declaration be executed by each inventor.

Analysis of the Petition Pursuant to Rule § 1.48(a)(3)

Petitioner has met requirements (1) - (2) and (4) - (5) of Rule § 1.48. Regarding the third requirement, Petitioner has failed to provide an oath or declaration that has been executed by the actual inventors, as required by 37 C.F.R. § 1.63, and pursuant to the discussion above, this requirement has not been waived.

Conclusion

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.48 and 1.183". This is not a final agency action within the meaning of 5 U.S.C § 704.

Petitioner will note that a grantable petition pursuant to 37 C.F.R. § 1.47(a) must be filed, before the Office will accept a partially-executed declaration.¹

¹ See MPEP §§ 409, 409.03, 409.03(a), and 409.03(d).

It is noted that the Arthur, Elliott, and Willis declarations of facts each refer to Internet searches that were performed for non-signing inventor Cumming. Petitioner may wish to consider submitting a Rule 1.47(a) petition, along with a copy of these searches, so as to place the Office in a position where it can be determined whether the searches were sufficiently broad so as to provide a reasonable chance at locating this individual.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,² hand-delivery,³ or facsimile.⁴ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁵

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.⁶

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

4 (571) 273-8300- please note this is a central facsimile number.

5 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.